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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,609	01/17/2001	Donald W. Malackowski	29997/035A	7844

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J. William Frank, III
McCracken & Frank
200 W. Adams
Suite 2150
Chicago, IL 60606

EXAMINER

LEUBECKER, JOHN P

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 02/04/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary

Application No.

09/764,609

Applicant(s)

MALACKOWSKI ET AL.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 80-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 80-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

1. The abstract of the disclosure is objected to because it does not adequately summarize the invention. Correction is required. See MPEP § 608.01(b).

This objection has been repeated from the previous Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 6, 8, 9, 13-34, 80-84, 86-93, 95, 96 and 100-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. (U.S. Pat. 5,617,857).

Chader et al. discloses the device as set forth in numbered paragraph 9 of the previous Office Action, paper number 13, wherein the transceiver includes hard wires. Wireless transmission of signals is old and well known. Where there is a limited universe of potential options, the selection of any particular option would have been obvious to one of ordinary skill in the art. In re Jones, 412 F.2d 241, 162 USPQ 224 (CCPA 1969). Since one of ordinary skill in the art is limited to either wireless or hard wired transmission of signals, the selection of either known option would have been obvious to the ordinarily skilled artisan. Wireless transmission would be desirable to eliminate a binding attachment between components allowing free movement and less entanglements.

4. Claims 1-3, 5, 6, 8, 9, 13-34, 80-84, 86-93, 95, 96 and 100-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. in view of Acker et al. (U.S. Pat. 6,453,190).

Chader et al. discloses the device as set forth in numbered paragraph 9 of the previous Office Action, paper number 13, wherein the transceiver includes hard wires. Acker et al. discloses a similar system wherein it is taught that hard-wired connections can be replaced with wireless connections to “avoid the physical encumbrance of loose wires trailing the instrument” (col.11, line 61 to col.12, line 4). In view of this teaching and motivation, it would have been obvious to one of mere ordinary skill in the art to have made the hard-wired connections of Chader et al. wireless.

5. Claims 4, 7, 10-12, 85, 94 and 97-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. for the reasons set forth in numbered paragraph 11 of the previous Office Action, paper number 13.

6. Claims 4, 7, 10-12, 85, 94 and 97-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. in view of Acker et al. for the reasons set forth in numbered paragraph 11 of the previous Office Action, paper number 13.

Response to Arguments

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7. Applicant's arguments filed June 19, 2003 have been fully considered but they are not persuasive.

Applicant states that the Chader patent “does not in any way disclose or suggest a device using wireless two way communication as the only bi-directional communication link between the tracking device and the navigation system”. This is essentially the position the Examiner has taken and the reason for the rejection under 35 U.S.C. 103(a) instead of under 35 U.S.C. 102. Please note the rejection appearing above.

Applicant also argues that Chader does not render the rejected claims obvious because it is the physical connection of the instrument to the system that triggers the recognition of the instrument by the system. **The reason for this is the fact that the Chader system is hard-wired—something that the Examiner and Applicant both agree on.** Clearly, it appears that Applicant is arguing the differences between the disclosed invention and the Chader reference without taking into consideration the obvious modification proposed by the Examiner. Since the Examiner has not withdrawn his position set forth in the rejections, the Examiner will not entertain any additional arguments regarding the Chader reference unless they are with respect to the proposed rejections.

With respect to the Acker patent, Applicant points out that the Acker patent “does not disclose a device that communicates bi-directionally with a navigation system”. If it did, it would probably be an anticipatory reference with respect to the claimed invention. However, the Examiner only relies on this reference as teaching the obvious substitution of wireless communication for hardwired communication in the event that Applicant did not agree that such

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substitution would be obvious to the skilled artisan without a specific teaching. The fact that Acker does not discuss “bi-directional” communication is not relevant—Chader does.

It is noted that the nonobviousness of claims 4, 7, 10-12, 85, 94 and 97-99 are only attributed to their dependence from claims considered non-obvious by Applicant.

Conclusion

8. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

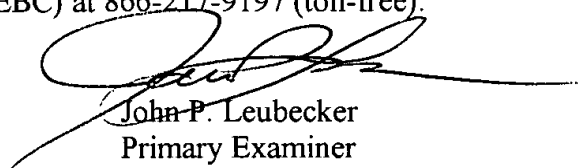
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl